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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/237,605	01/25/99	LAZZARA R	IMPI.035-1

QM12/1217

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EXAMINER	
PREBILIC,P	
ART UNIT	**PAPER NUMBER**
3738	6

DATE MAILED: 12/17/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/237,605	Lazzara et al
Examiner	**Group Art Unit**
Paul Prebilic	3738

☒ Responsive to communication(s) filed on *Jul 26, 1999* .

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *11-50* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *11-50* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☒ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *5*

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Specification

The disclosure is objected to because of the following informalities:

On page 1 of the specification, the continuing data is not clear because it references 09/650,594 and a PCT application which are not clearly part of the filial chain as being parent continuing applications. For clarity, the Examiner suggests deleting the entire entry made March 16, 1999 and reinserting the continuity data only referencing the parental continuing applications.

Appropriate correction is required.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

> It does not state that the person making the oath or declaration in a continuation-in-part application filed under the conditions specified in 35 U.S.C. 120 which discloses and claims subject matter in addition to that disclosed in the prior copending application, acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56 which occurred between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

Specifically, the declaration fails to identify the parent applications which are now claimed to be such in the continuing data inserted into the first page of the specification.

Information Disclosure Statement

The information disclosure statement filed April 2, 1999 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it does not provide copies of all cited references which were not cited and provided in the parent applications. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Specifically, since the information disclosure statement of April 2, 1999 did not provide copies of the cited references which were not cited or provided in the parent applications, it has not been considered at this time. Specifically, US 5,344,457, US 5,588838, Albrektsson et al (article from 1991), and Baier, R.E. et al article entitled "Surface Energetics . . . " were not cited or provided in the parent applications 08/778,503 and 08/607,903, yet they were cited on the April 2, 1999 IDS without a copy being provided. The Examiner could consider only the parent cited references without a fee or Applicant could provide copies to the non-parent-cited references with a fee so that IDS as a whole could be considered. As a courtesy, the Examiner would prefer the Applicant to provide a copy of all cited prior art from this IDS.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 11-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 5,876,453. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims are drawn to the same embodiment except that the patented are more detailed with regard to the overall structure but fail to set forth the claimed peak to valley height. However, since the peak to valley height would obviously result from the acid etching process, it is the Examiner's position that the present claims are obvious over the patented claims.

Claims 17-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 5,863,201. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims are drawn to the same embodiment except that the patented are more detailed with regard to the overall structure. However, the claim scopes in each claim set are so similar

such that it is the Examiner's position that the present claims are clearly obvious over the patented claims.

Claims 22-24 and 26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-12 of U.S. Patent No. 5,863,201. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims are drawn to the same embodiment except that the patented are more detailed with regard to the overall structure but fail to set forth the claimed peak to valley height. However, since the peak to valley height would obviously result from the acid etching process, it is the Examiner's position that the present claims are obvious over the patented claims.

Claims 27-50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-7 of U.S. Patent No. 5,876,453. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims are drawn to the same embodiment except that the patented are more detailed with regard to the overall structure but fail to set forth the claimed peak to valley height. However, since the peak to valley height would obviously result from the acid etching process, it is the Examiner's position that the present claims are obvious over the patented claims.

Claim Rejections Based Upon Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 11-16, 22-25, and 27-49 are rejected under 35 U.S.C. 102(b) as anticipated by Krueger (US 4,826,434) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Krueger (US 4,826,434) alone. Krueger anticipates the claim language wherein Krueger teaches a threaded surface intermediate product which has been etched to remove impurities; see the whole document, especially Figure 3 and Col. 3, line 38 to Col. 4, line 7. The Examiner asserts that at least one of the intermediate product (Col. 3, lines 50-56) and the final etched product would have their native oxide layers removed and would have irregularities of less than 10 microns approaching 0 microns.

Alternatively, it is not clear that the intermediate product surface has a native oxide layer removed, but the Examiner posits that the etching process to increase the surface area by two would obviously remove the native oxide layer to the extent claimed and the Examiner hereby burdens Applicant to show that the product disclosed by Krueger does not meet or obviate the claimed invention. Since the Office does not have facilities to test the prior art against the

Applicant's invention, it is the Examiner prerogative to burden the Applicant to do the same when certain physical properties appear to be present in the prior art even though not explicitly taught thereby.

With regard to claims 12, 25, 28, 38, 46, and 47, the Examiner posits that since the same etching process is used to form irregularities on the surface of the same material as claimed that the surface irregularities of Krueger would inherently be the same as those set forth in the claims; i.e. cone shaped.

With regard to claims 13 and 36, the Examiner posits that the claimed process steps result in the same invention such that the claimed invention is at least clearly obvious in view thereof. The Examiner is also under a lesser burden to show that process limitations in product claims are met; see MPEP 2113 which is incorporated into this Office action by reference thereto.

With regard to claim 34, the Examiner takes the position that smooth is a term of relative degree such that even the etched surfaces of Krueger are smooth to the extent required by the claims. The Examiner notes that there is no comparison of the smooth surface recited in this claim to other surfaces of the same implant.

Claims 26 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krueger as applied to claims 11-16, 22-25, and 27-49 above, and further in view of Wagner et al (US 5,989,027). Krueger at least obviates the claim language as set forth in the above rejection but fails to teach both a roughened region and an unroughened or other region as required by the claims. Wagner et al teaches that it was known in the art to have different regions of roughness;

see the entire document. Hence, it is the Examiner's position that it would have been obvious to have a smoother head portion in the Krueger invention for the same reasons that Wagner et al has the same.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (703) 308-2672. The fax phone number for this Technology Center is (703) 305-3580.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.

Paul Prebilic
Primary Examiner
Art Unit 3738